REMARKS

The Office Action dated April 13, 2010, ("Office Action") has been received and carefully considered. Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

Claims 1-21 and 23-30 are pending. By this Amendment, claims 1, 15, 25, and 29 are amended. No new matter is presented.

I.   THE NON-STATUTORY SUBJECT MATTER REJECTION OF CLAIMS 1-14, 29, AND 30

On pages 2-4 of the Office Action, claims 1-21 and 23, 24, 29, and 30 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. This rejection is hereby respectfully traversed.

Regarding claim 1, the Office Action maintains that the recited modules in claim 1 constitute a series of software programs. Also, the Office Action asserts that the recited engine is merely delineated as "associated" with the respective module and further as "being accessible over a network" and is therefore not positively recited as a system component. Applicant respectfully disagrees. However, in order to forward the present application toward allowance, Applicant has amended claim 1 to more clearly recite a process that: (1) is tied to a particular machine or apparatus, or (2) transforms a particular article into a different state or thing. Further, Applicant submits that claim 1 does recite system components or hardware. In particular, Applicant submits that the instant Specification discloses that the "server station 30 may include, for instance, a <u>workstation</u> running," various operation system or platforms (emphasis added). *See, e.g.*, page 7, line 30 to page 8, line 6. Also, the instant Specification discloses that the server

station may include an administration module 60 and a filter module 70. *See, e.g.*, Figure 2, page 10, line 4 to page 11, line 9. Applicant submits that claim 1 recites "a filtering module of an engine" and "an administration module of the engine," wherein the engine is a server station, as disclosed in the instant Specification. Accordingly, Applicant respectfully submits that claim 1 is directed to statutory matter.

Applicant respectfully submits that independent claim 1 clearly recites a method that: (1) is tied to a particular machine or apparatus, or (2) transforms a particular article into a different state or thing. In particular, Applicant respectfully submits that independent claim 1 recites a method that is tied to various modules of a system. Furthermore, Applicant directs the Examiner to the case law set forth in In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995) and Ex parte Lundgren, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005), and others, which clearly provide a patentable subject matter basis for claim 1. Also, Applicant notes that the Board, in *Ex parte Bo Li*, Appeal No. 2008-1213, recently cited similar "modules" and concluded that the claim at issue in that case constituted statutory subject matter under 35 U.S.C. § 101. *Bo Li* at p. 9.

Claim 29, while different in scope from claim 1, contains similar limitations. Thus, claim 29 is also directed towards statutory subject matter.

Claims 2-14 and 30 are dependent upon independent claims 1 and 29 and thus inherently incorporate all of the limitations of independent claims 1 and 29. Thus, claims 2-14 and 30 should also be allowable at least by virtue of their dependency on independent claims 1 and 29.

In view of the foregoing, Applicant respectfully requests that the aforementioned non-statutory subject matter rejection of claims 1-14, 29, and 30 be withdrawn.

II.   THE OBVIOUSNESS REJECTION OF CLAIMS 1, 2, 4-7, 9-21, 23-28, AND 30

On page 4 of the Office Action, claims 1, 2, 4-7, 9-21, 23-28, and 30 are currently rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,272,528 to Cullen *et al.* ("Cullen") in view of U.S. Patent No. 5,835,087 to Herz *et al.* ("Herz") and further in view of U.S. Patent Application No. 2002/0120477 to Jinnett ("Jinnett"). This rejection is hereby respectfully traversed.

As stated in MPEP § 214 3, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the Office Action has not met the burden of proof in establishing the obviousness of independent claim 1 because Cullen in view of Herz and further in view of Jinnett, taken either individually or in combination, do not teach or suggest all the claimed features. Further, the Office Action has failed to adequately explain the motivation to combine the applied art to Cullen, Herz, and Jinnett.

Regarding claim 1, the Office Action asserts that the claimed invention would have been obvious in view of Cullen, Herz, and Jinnett. Applicant respectfully disagrees. However, in order to forward the present application toward allowance, Applicant has amended claim 1 to more specifically define the claimed invention, and specifically those features that further

differentiate the claimed invention from Cullen, Herz, and Jinnett, as well as the other cited references. In particular, Applicant submits that Cullen, Herz, and Jinnett, either alone or in combination, fail to disclose, or even suggest, a system for personalizing and delivering insurance or financial services-related content to a user, comprising: a filtering module of an engine configured to: (1) determining information about the user based on the user's historical access pattern to particular insurance products or policies and products and services the user is authorized to sell based at least in part on an IP address associated with the user," as presently recited in claim 1. The Office acknowledges, and Applicant agrees, that Cullen and Herz fail to disclose such claimed features, however, the Office asserts that Jinnett discloses such claimed features and concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Cullen, Herz, and Jinnett.

In contrast, Applicant submits that Jinnett discloses a communication network for processing regulated transactions that complies with substantially material applicable regulatory requirements, such as electronic signatures and records, privacy laws, advertising guidelines and the like, for that jurisdiction. *See, e.g.,* paragraph [0015]. Jinnett also discloses in Figure 2, two categories of customer inquiries: status inquiries and transactional inquiries. Specifically, status-type inquiries from consumers are transmitted to a database query facility and the database query facility maintains electronic records of consumer messages and transactions in individual databases conforming to applicable state requirements. *See, e.g.,* paragraph [0074]. Transactional-type inquiries are transmitted from an insurance company's website to an extranet site customized to match the legal regulatory requirements of the applicable jurisdiction (e.g., New York or California). *See, e.g.,* paragraphs [0077-0078]. Thus, Applicant submits that Jinnett, at most, discloses, facilitating transactions that complies with substantially material

applicable regulatory requirements of a consumer and fails to disclose, or even suggest, a filtering module of an engine configured to: (1) determining information about the user based on the user's historical access pattern to particular insurance products or policies and products and services the user is authorized to sell based at least in part on an IP address associated with the user," as presently recited in claim 1. Accordingly, Applicant respectfully submits that claim(s) should be allowable over Cullen, Herz, and Jinnett.

In the Response to Argument section of the Office Action, the Office maintains that Jinnett discloses tailoring insurance products to regulatory requirements of the jurisdiction of the purchasing consumer and thus constitutes a determination of products "the user is authorized to sell" based on the jurisdictional determination. Applicant respectfully disagrees. In fact, Jinnett discloses that once a consumer 14 access an insurance company's website 12 for policy information and indicates a desire to perform a transaction (e.g., purchase an insurance policy, change a beneficiary, terminate a policy, etc.), the consumer 14 is prompted for his or her state of residence or key jurisdiction of legal relevance to the desired transaction. *See, e.g.,* paragraph [0077]. Thus, Applicant respectfully submits that Jinnett, at most, discloses a consumer purchasing an insurance policy and fails to disclose, or even suggest, a filtering module of an engine configured to: (1) determining information about the user based on the user's historical access pattern to particular insurance products or policies and products and services the user is authorized to sell based at least in part on an IP address associated with the user," as presently recited in claim 1.

Also, the Office appears to equate the insurance agent of Cullen to the recited filtering module in claim 1. Applicant respectfully disagrees. In contrast, Cullen merely discloses that "the insurance agent requests information from the user's preference agent." *See,* e.g., column 5,

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lines 61-62. The insurance agent of Cullen does not <u>determine</u> information about the user, but rather, <u>requests</u> user information from the preference agent. Moreover, the preference agent of Cullen fails to perform the step of "<u>determining</u> information about the user," as recited in claim 1. Instead, the preference agent of Cullen merely "handle[s] requests for information about user preferences" and "collects the required information from the user." *See*, e.g., column 4, lines 34-35 and column 5, line 67. In the Response to Argument section of the Office Action, the Office Action asserts that the <u>gathering and assembly</u> of preference information from the user as needed by the preference agent and subsequent gathering of insurance products from vendors that is tailored according to the preference information constitutes "determining information about the user." *See*, e.g., page 28 of the Office Action. Applicants respectfully disagree. Specifically, Applicant respectfully submits that gathering and assembly of information of Cullen cannot constitute "<u>determining</u> information about the user <u>based on</u> the user's historical access pattern to particular insurance products or policies and products and services the user is authorized to sell," as recited in claim 1. Thus, Applicant respectfully submits that Cullen fails to disclose, or even suggest, "determining information about the user," as recited in claim 1.

Further, Cullen fails to disclose, or even suggest, a filtering module "for <u>personalizing</u> and delivering the at least one insurance or financial services-related product or service based on the information about the user," as recited in claim 1. The Office Action alleges that the insurance agent of Cullen teaches such recitation. Also, in the Response to Argument section of the Office Action, the Office Action asserts that the <u>gathering and assembly</u> of preference information from the user as needed by the preference agent and subsequent gathering of insurance products from vendors that is tailored according to the preference information constitutes "personalizing the deliverable content to the user." *See*, e.g., page 28 of the Office

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Action. Applicant respectfully disagrees. In particular, Applicant submits that claim 1 defines that "personalizing the at least one insurance or financial service-related product or service comprises identifying at least one insurance or financial services-related produce and service the user is authorized to sell." (Emphasis added). However, the Office Action admits, and Applicant agrees, that Cullen fails to disclose, or even suggest, that the system is applied to selling entities and specifically locates items the user is "authorized to sell." In contrast, the insurance agent of Cullen merely arranges the received quotations from a quotation agent in order of price/suitability. In addition, Cullen merely discloses the agent-manager presents the user with a bookmark list, comprising a list of agents available for the user to select, wherein the list of agents are for performing a number of different financial services for the user. *See, e.g.,* column 5, lines 19-30. Nowhere, does Cullen disclose that the insurance agent personalizes the at least one insurance or financial services-related or services by "identifying at least one insurance or financial services-related product and service the user is authorized to sell," as recited in amended claim 1. (Emphasis added).

Furthermore, the Office Action asserts that under the broadest reasonable interpretation, the agent-based search engine of Cullen retrieves information from a stored profile which is used repeatedly each time a search is performed and thus retrieves information based on the same or slightly modified user profile information each time (i.e., based on a historical access pattern). Applicant respectfully disagrees. Applicant submits that Cullen merely discloses an intermediary agent server 13 providing a user preferences and profile store, for storing information about users." *See, e.g.,* column 3, lines 22-33. Nowhere does Cullen disclose, or even suggest, that the user preferences and profile store are used repeatedly each time a search is performed, as alleged in the Office Action. Thus, Applicant respectfully submits that under the

broadest reasonable interpretation, Cullen fails to disclose, or even suggest, "determining information about the user based on the user's historical access pattern to particular insurance products or policies," wherein "the user's historical access pattern to particular insurance products or policies comprises one or more insurance products or policies that the user expressed interest in during a previous access to the system," as recited in claim 1.

The Office Action asserts, and Applicant agrees, that Cullen fails to disclose, or even suggest, that the information about the user is "based on the user's historical access pattern to particular insurance products or policies and products and services the user is authorized to sell," "identifying at least one insurance or financial services-related product and service the user is authorized to sell," and "an administration module associated with the engine," as recited in independent claim 1. However, the Office Action relies on Herz and Jinnett to remedy the deficiencies of Cullen. Applicant respectfully disagrees. In contrast, Herz appears to be concerned with "a filtering system in the system for customized electronic identification of desirable objects automatically selects a set of articles that the user is likely to wish to read." *See*, e.g., column 7, lines 22-25, Emphasis added. Nowhere does Herz disclose, or even suggest, "the user's historical access pattern to particular insurance products or polices comprises one or more insurance products or polices that the user expressed interest in during a previous access to the system," as recited in claim 1. Moreover, Herz appears to implement the filtering system by comparing the frequency with which each word appears in an article relative to its overall frequency of use in all articles with the target profile interest summary containing user's interest level in various types of target objects. *See*, e.g., Abstract. In addition, Herz merely discloses that the accuracy of the filtering system improves over time by noting which articles the user reads and by generating a measurement of the depth to which the user reads each article. *See,*

e.g., column 7, lines 25-27. Therefore, Herz fails to disclose, or even suggest, that "the user's historical access pattern to particular insurance products or polices comprises one or more insurance products or polices that the user expressed interest in during a previous access to the system," as recited in claim 1.

The Office Action asserts that the Examiner interprets that the filtering of and associated interest profile of Herz is "based on one or more products or policies that the user was interested in during a previous access to the system." *See, e.g.,* page 7 of the Office Action. Applicant respectfully disagrees. In contrast, Herz merely discloses a system for developing and using profiles for article retrieval with the basic implementation of an on-line news clipping service. The system includes a system to filter electronic mail, an extension for retrieval of target objects such as purchasable items which may have more complex descriptions, a system to automatically build and alter menuing systems for browsing and searching through large numbers of target objects, and a system to construct the virtual communities of people with common interests." *See,* e.g., column 7, lines 48-58. Thus, Applicant submits that Herz, at most, discloses an on-line new clipping services and fails to disclose, or even suggest, that the filtering of and associated interest profile is "based on one or more products or policies that the user expressed interest in during a previous access to the system," as alleged in the Office Action.

Additionally, the Office Action asserts, that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combine the teachings of Cullen with those of Herz to direct subsequent queries to products and services that are relevant to the user's interest without requiring the user to expend an excessive amount of time and energy searching for the information. Applicant respectfully disagrees. Applicant respectfully submits that Cullen teaches away applying the filtering system to a seller as the Office Action

asserts. Specifically, Applicant submits that Cullen discloses "a customer wishing to purchase vehicle insurance, or a broker acting on behalf of a client, could access the websites of a number of insurance company to obtain the cheapest quotation to get a quotation which is most suitable to a consumer's needs." *See*, e.g., column 1, lines 12-16. Therefore, the system of Cullen appears to apply to a consumer and not a seller as asserted by the Office Action. Even the broker accessing the system of Cullen, the broker is acting on behalf of a client by buying insurance. Therefore, Applicant respectfully submits that the system of Cullen would not be accessible to a seller as asserted by the Office Action.

Regarding claims 2, 4-7, 9-14, and 30, these claims are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2, 4-7, 9-14, and 30 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

Regarding claims 15 and 25, while different in overall scope from claim 1, these claims recite subject matter related to claim 1. Thus, at least some of the arguments set forth above with respect to claim 1 are applicable to claims 15 and 25. Accordingly, Applicant respectfully submits that claims 15 and 25 are allowable over cited references for the same reasons as set forth above with respect to claim 1.

Moreover, regarding claims 16-21, 23, 24, and 26-28, these claims are dependent upon independent claims 15 and 25. Thus, since independent claims 15 and 25 should be allowable as discussed above, claims 16-21, 23, 24, and 26-28, should also be allowable at least by virtue of their dependency on independent claims 15 and 25. Moreover, these claims recite additional

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features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, Applicant respectfully requests that the aforementioned obviousness rejection of claims 1-2, 4-7, 9-21 and 23-28 be withdrawn.

III.   THE OBVIOUSNESS REJECTION OF CLAIM 3

On page 14 of the Office Action, claim 3 is currently rejected under 35 U.S.C. § 103(a) as being unpatentable over Cullen, in view of Herz and Jinnett, and further in view of Quido (U.S. Patent Application Publication No. 2003/0093302). This rejection is hereby respectfully traversed.

Applicant respectfully submits that the aforementioned obviousness rejection of claim 3 has become moot in view of the deficiencies of the primary references (i.e., Cullen, Herz, and Jinnett) as discussed above with respect to independent claim 1. That is, claim 3 is dependent upon independent claim 1 and thus inherently incorporates all of the limitations of independent claim 1. Also, the secondary reference (i.e., Quido) fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claim 1. Indeed, the Examiner does not even assert such. Thus, the combination of the secondary reference with the primary references also fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claim 1. Accordingly, claim 3 should be allowable over the combination of the secondary reference with the primary references at least by virtue of its dependency on independent claim 1. Moreover, claim 3 recites additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, Applicant respectfully requests that the aforementioned obviousness rejection of claim 3 be withdrawn.

IV. THE OBVIOUSNESS REJECTION OF CLAIM 8 AND 29

On page 15 of the Office Action, claims 8 and 29 are currently rejected under 35 U.S.C. § 103(a) as being unpatentable over Cullen, in view of Herz and Jinnett, and further in view of Parker (U.S. Publication No. 2003/0182290). This rejection is hereby respectfully traversed.

Applicant respectfully submits that the aforementioned obviousness rejection of claim 8 has become moot in view of the deficiencies of the primary references (i.e., Cullen, Herz, and Jinnett) as discussed above with respect to independent claim 1. That is, claim 8 is dependent upon independent claim 1 and thus inherently incorporates all of the limitations of independent claim 1. Also, the secondary reference (i.e., Parker) fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claim 1. Indeed, the Examiner does not even assert such. Thus, the combination of the secondary reference with the primary references also fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claim 1. Accordingly, claim 8 should be allowable over the combination of the secondary reference with the other references at least by virtue of its dependency on independent claim 1. Moreover, claim 8 recites additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

For example, claim 8 recites "the **administration interface** further comprises **scanning** means for uploading insurance or financial services-related information." The Office Action merely cites to paragraph 23 of Parker as disclosure of such recitation. Applicant respectfully

disagrees. In contrast, Parker teaches "it is not necessary for the client to store all information with the ELOP program administrator." Rather, Parker teaches scanning documents to be stored by the ELOP program provider. Moreover, nowhere does Parker disclose, or even suggest, an "administration interface further comprises scanning means for uploading insurance or financial service-related information," as presently recited.

Regarding claim 29, while different in overall scope from claim 1, this claim recites subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claim 29. Also, the secondary reference (i.e., Parker) fails to disclose, or even suggest, the deficiencies of the primary references (i.e., Cullen, Herz, and Jinnett) as discussed above with respect to independent claim 1. Indeed, the Examiner does not even assert such. Thus, the combination of the secondary reference with the primary references also fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claim 29. Accordingly, Applicant respectfully submits that claim 29 is allowable over cited references for the same reasons as set forth above with respect to claim 1.

In view of the foregoing, Applicant respectfully requests that the aforementioned obviousness rejection of claims 8 and 29 be withdrawn.

VI. CONCLUSION

In view of the foregoing, Applicant respectfully submits that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

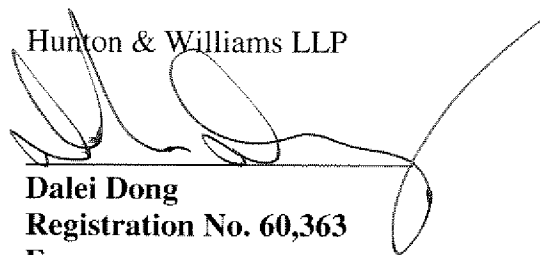To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

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